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OFFICE OF PETITIONS

In re Application of
Endo, et al.
Application No. 09/080,861 : ON PETITION
Filed: 18 May, 1998
Attorney Docket No.: 01272.006808.2

This is a decision on the petition filed on 7 May, 2002, under 37 C.F.R. §1.182[1] to grant the previously unstated priority claims--considered properly under 37 C.F.R. §1.78[2]--and

[1] The regulations at 37 C.F.R. §1.182 provide:
**§ 1.182 Questions not specifically provided for.**
All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).
[47 Fed. Reg. 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

[2] The regulations at 37 C.F.R. §1.78 provide:
**§1.78 Claiming benefit of earlier filing date and cross-references to other applications.**
(a)(1)A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor 's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112.In addition, each prior-filed application must be:

(I) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Complete as set forth in § 1..51(b);or

(iii) Entitled to a filing date as set forth in §1.53(b)or § 1..53(d)and include the basic filing fee set forth in §1.16; or

(iv) Entitled to a filing date as set forth in §1.53(b)and have paid therein the processing and retention fee set forth in § 1.21((l)within the time period set forth in §1.53(f).

(2)(I) Except for a continued prosecution application filed under § 1..53(d),any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number)or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a),this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b)or (f)in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3)of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph a(2)(I)of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c)to such prior-filed application.

The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111 (a)before November 29, 2000; or

© A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29,2000.

(iii) If the later-filed application is a non-provisional application, the reference required by this paragraph must be included in an application data sheet (§1.76), or the specification must contain or be

supplemented on 17 January, 2003.

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amended to contain such reference in the first sentence following the title.

(iv) The request for a continued prosecution application under § 1..53(d)is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2)of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2)(ii)of this section, the claim under 35 U.S.C. 120, 121, or 365(c)for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed.

A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, OR 365© for the benefit of a prior-filed application must be accompanied by:

(I) The reference required by 35 U.S.C. 1·20 and paragraph (a)(2)of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1..17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii)of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor 's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in §1.53((c), and the basic filing fee set forth in § 1.16(k)must be paid within the time period set forth in §1.53(g).

(5)(I) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a),this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b)or (f)in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph(a)(6)of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e)to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application filed under 35 U.S.C. 111(a)before November 29, 2000; or

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29,2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§1.76),or the specification must contain or be amended to contain such reference in the first sentence following the title.

(iv) If the prior-filed provisional application was filed in a language other than English and an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application or the later-filed nonprovisional application, applicant will be notified and given a period of time within which to file an English-language translation of the non-English-language prior-filed provisional application and a statement that the translation is accurate. In a pending nonprovisional application, failure to timely reply to such a notice will result in abandonment of the application.

(6) If the reference required by 35 U.S.C. 119(e)and paragraph (a)(5)of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5)(ii)of this section, the claim under 35 U.S.C. 119(e)for the benefit of a prior filed provisional application may be accepted during the pendency of the later-filed application if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e)for the benefit of a prior filed provisional application must be accompanied by:

(I) The reference required by 35 U.S.C. 119(e)and paragraph (a)(5)of this section to the prior-filed provisional application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

© If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same party and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and, if not, indicate which named inventor is the prior inventor.

[36 Fed. Reg. 7312, Apr. 17, 1971; 49 Fed. Reg. 555, Jan. 4, 1984; paras.(a), © & (d), 50 Fed. Reg. 9380, Mar. 7, 1985, effective May 8, 1985 ;50 Fed. Reg. 11366, Mar. 21, 1985; para. (a) revised 58 Fed. Reg. 54494, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a)(1) and (a)(2) revised and paras. (a)(3) and (a)(4) added, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; para. © revised and para. (d) deleted, 61 Fed. Reg. 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a) revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(3) revised, 65 Fed. Reg. 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 Fed. Reg. 50092, Aug. 16, 2000); paras. (a)(2), (a)(4), and © revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Sept. 8, 2000; paras. (a)(2), (a)(3), and (a)(4) revised and paras. (a)(5) and (a)(6) added, 65 Fed. Reg. 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (a) revised, 66 Fed. Reg. 67087, Dec. 28, 2001, effective Dec.28, 2001]

The petitions under 37 C.F.R. §1.78 and 37 C.F.R. §1.182 are **GRANTED**.[3]

## BACKGROUND

The record indicates that:

- according to the transmittal, Petitioner filed the instant application on 18 May, 1998, as a divisional of prior Application No. 08/892,881, filed 15 July, 1997 (the '881 application), now issued as Patent No. 5,754,304;

- Petitioner alleges that:

  --Petitioner filed the instant application using the original declaration from "grandparent" Application No. 08/312,923, filed 30 September, 1994 (the '923 application), now abandoned;

  --however, in this application, in which a continued prosecution application (CPA) was filed on 9 August, 2001, Petitioner failed to claim expressly priority to the '923 and the '881 application, pursuant to 37 C.F.R. §1.78.

Petitioner seeks to correct the oversight[4] to make the claims for priority[5] during prosecution of the instant application as required.[6]

Petitioner, however, is incorrect that a petition and fee are not required herein.

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[3] Pursuant to Petitioner's authorization, the petition fee of $130.00 is charged to Deposit Account 06-1205.

[4] Punctuality, diligence and good faith are essential to the success of those who seek to obtain and retain the special privileges of patent law, and required in the public interest and protection of rival inventors. For more than a century punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

[5] Invention benefits no one unless it is made public, and the rule of diligence must applied as to encourage reasonable promptness in conferring this benefit upon the public. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183. See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997). See also: Ray v. Lehman, supra.

[6] Patent prosecution does not require perfection. Rather, the touchstone of diligence in patent prosecution was defined more than a century ago as the attention given by prudent and careful persons to their most important business affairs. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

CONCLUSION

A request for a CPA is an express request to abandon the prior application as of the filing date of the request. (See: 35 C.F.R. §53(d)(1)(v). Moreover, the request for a CPA is the specific reference required by 35 U.S.C. §120 to every application assigned the application number.

Thus 35 U.S.C. §120 permits entry of a subsequent amendment to an abandoned application in applications filed prior to 29 November, 2000, to include the benefit of an earlier filing date for purposes other than prosecution.[7]

Therefore, the instant petitions are **granted**.

This application is forwarded OIPE for:

- inclusion in the bibliography of the instant application the priority claims to:

  --Application No. 08/892,881, filed 15 July, 1997 (now issued as Patent No. 5,754,304); and

  --Application No. 08/312,923, filed 30 September, 1994 (now abandoned); and

- issuance of a corrected filing receipt for the instant application to reflect those priority claims.

Thereafter, the application will be forwarded for further processing in due course.

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 305-9199.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[7] See: Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136 (DC DC 1976).